

Notice of Allowability

Application No.

10/721,953

Examiner

John Sipos

Applicant(s)

BRENKUS ET AL.

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to ____.
2. ☒ The allowed claim(s) is/are 1-8.
3. ☒ The drawings filed on 25 November 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date ____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date ____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date ____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other ____

RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-8, drawn to a method of making packages, classified in Class 53, subclass 131.5.

Group II. Claims 9-17, drawn to a package, classified in Class 206.

Group III. Claims 18-22, drawn to a method and apparatus for perforating a film, classified in Class 493.

The inventions of Groups I and II are related as **process of making and product made**. The inventions are distinct if either of the following can be shown: (1) that the process as claimed can be used to make other materially different products, or (2) that the product as claimed can be made by another materially different process (See MPEP 806.05(f)). In the instant case the packages set forth in the claims of Group II can be made by a process other than the one set forth in the claims of Group I. For example, the packages need not be made on a vertical form, fill and seal machine wherein a tube is sequentially sealed and three locations with the filling taking place between the sealing operations. The packages could be formed by providing two sheets and simultaneously sealing three transverse and one longitudinal seals to form attached bags that are then filled and sealed.

The inventions of Groups I and III are related as **combination and subcombination**. A restriction requirement is based on the presumption that all claims of record define patentable inventions. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for its presumed

patentability and (2) that the subcombination has utility by itself or in other combinations. (See MPEP 806.06(c)). In the instant case, a comparison of combination claim 1 and subcombination claims 18,21 provides evidence that the combination, as claimed, does not require the particulars of the subcombination, as claimed, for its presumed patentability. Subcombination claims 18,21 set forth a specific perforation pattern. Combination claim 1 does not set forth these particulars and, consequently, does not require them for patentability. Even if other combination claims *do* set forth these particulars, distinction between the *inventions* is shown if any one combination claim does not include the particulars of any one subcombination claim. The presence of the particulars in other combination claims indicates that they *may be* included as part of the combination, but the claims selected above provide evidence that the particulars are not *required*. (See MPEP 806.05(c), Example 3.) The subcombination has separate utility because it can be used in packaging operations without the rest of the combination.

The inventions of Groups II and III are **independent inventions**. Two **different combinations**, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent (See MPEP 806.04). A **process and apparatus** are independent if the apparatus cannot be used to practice the process or any part thereof (See MPEP 806.04).

Because these inventions are distinct for the reasons given above, and because they have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes, as indicated, is proper.

During a telephone conversation between Examiner John Sipos and Mr. W. Wang, attorney of record in this case, on 1/5/2005, a provisional election was made with traverse to

prosecute the invention of Group I comprising claims 1-8. Claims 9-22 are withdrawn from further consideration by the examiner as being drawn to a non-elected invention. (See 37 CFR 1.142(b)). An action on the merits of the elected claims follows.

Applicant is reminded that, upon cancellation of claims to a non-elected invention, the **inventorship must be amended** in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h). Applicant should further **amend the title**, in necessary, to reflect the elected invention.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. W. Wang on January 6, 2005.

In the specification, page 2, in line 4, after "2002" the phrase --now US patent 6,722,106-- has been inserted.

In claim 1, lines 3 and 5, "graphics" has been replaced with --lettering--;

line 11 has been cancelled;

in lines 12,13,15,16 and 17, "g)", "h)", "i)", "j)", "k)" have been replaced with --f)--, --g)--, --h)--, --i)--, --j)--, respectively.

in line 19, "thereby forming" has been replaced with --k) cutting across the third seal to form--; and

in line 20 "wherein said graphics" and lines 21 and 22 have been replaced with the following new paragraph:

-- 1) standing up the connected first and second bags so that they are horizontally adjacent to each other such that the first, second and third transverse seals are vertically oriented and the lettering is oriented upright.--.

Claims 9-22 have been cancelled.

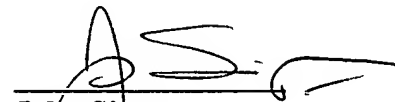
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **571-272-4468**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at **571-272-4467**.



John Sipos
Primary Examiner